

Remarks

In the present Office Action, the Examiner rejected all of the present claims under 35 USC 102(b) as being anticipated by US Patent 5,912,205 to Lakes et al (hereinafter the '205 patent) or under 35 USC 103(a) as being unpatentable over the '205 patent either alone, or in conjunction with one or more secondary references. The Applicants note with appreciation the willingness of both the Examiner and his Supervisor to discuss the particulars of the present Office Action with the undersigned in telephone interviews on May 31, 2007 and June 4, 2007 respectively. The above amendments and following remarks are made in the spirit of those interviews.

All of the amended claims of the present invention require the two security coatings, where one is on top of the other, and one is sensitive to a solvent and the other sensitive to abrasion. Each provide indicia of tampering that shows a different warning from one another. Furthermore, each warning must be produced in the respective coating. The '205 patent teaches a heat-resistant security coating for use on security documents being printed through laser printers and other heated printing devices. The coating (described as a color-forming composition) is sensitive to solvents, abrasion and heat. It further teaches the coating may be in the form of warning indicia (e.g., VOID), authenticating indicia (e.g., VALID), or both. The '205 patent teaches an additional insulating material **15**, as well as a toner-adhesion enhancing coating **16** (as shown in FIG. 1 of the '205 patent).

There is nothing in the '205 patent that teaches two separate coatings layered one on top of the other such that each coating provides a distinct tampering warning. Even though the toner-adhesion enhancing coating **16** is depicted as being a separate layer that is on top of the tamper-evident coating **14**, there is no indication that it provides evidence of tampering produced in such top layer. In fact, its only apparent purpose is to provide "improved adhesion of toner particles to the security document when printed with a laser or other noncontact printer" as described at column 3, lines 5 through 7. In the aforementioned telephone interviews, the Examiners maintained that the mere removal of the toner-adhesion enhancing coating **16** is sufficient to show indicia of tampering. Specifically, the Examiners' position was that removal

of the toner-adhesion enhancing coating 16 would provide the claimed indicia of tampering, as such a local or complete lack of coating gives a clear visual clue (through such coating absence) that some form of tampering has been attempted. Both of the Examiners maintained during the respective telephone interviews that they are authorized to give the claims such a broad construction. In fact, MPEP 2111 authorizes an Examiner to give "the broadest reasonable interpretation consistent with the specification." The Applicants respectfully disagreed during the telephone interviews that such broad construction was warranted, noting first that the specification (including drawings) clearly shows and describes each coating layer as possessing the ability to provide a separate indicia of tampering, and second that absence of a top layer in the '205 patent as suggested by the Examiners is not the sort of indicia that was claimed in the independent claims that clearly required that the notorious indicia of tampering in one of the coatings is different than the notorious indicia of tampering in the other of the coatings. The Applicants remarked that it is a logical impossibility to have an indicia of tampering be evident *in* a coating by that coating's absence, as the approach adopted by the Examiners would equate lack of coating created by its partial or complete removal with tamper evidence in such coating. Nevertheless, at the end of the telephone interviews, the Examiners maintained the position set forth in the March 20 2007 Office Action.

Despite the Applicants disagreement with the Examiners' position, the Applicants have amended via this response independent claims 1, 33 and 43 to more particularly recite that each of the multiple coatings are capable of showing a different warning from one another, and that such warnings are produced in the coatings. Such warning may include words, phrases, color change or the like. By way of example, one coating may show a warning message in the form of words, phrases, patterns or the like, while the other coating may show a warning in the form of a color change. Support for the proposed claim amendments can be found in the original specification in numerous places. For example, support for one coating layer being capable of producing a warning message in the form of words, phrases or related patterns can be found at page 2, line 2, page 4, line 4, page 9, lines 1 through 9, and original claims 2, 3 and 34, while support for the other coating layer being capable of another warning in the form of a color change can be found in page 8, lines 13 through 14. The requirement that independent claims 1, 33 or 43 now recite that any evidence of tampering must include that each coating layer be

capable of providing its own unique warning clearly distinguishes both the '205 patent as well as the Examiners' explanation of what the '205 patent teaches, as the purported removal of the toner-adhesion enhancing coating **16** in the '205 patent cannot provide the claimed warning message produced in the coating that is different from a warning produced in tamper-evident coating **14** that lies beneath the toner-adhesion enhancing coating **16**. Specifically, any such indicia of tampering as may be produced in the device of the '205 patent is limited to that of tamper-evident coating **14**. Since there is no opportunity for such indicia to be produced in the toner-adhesion enhancing coating **16**, and that the amended claims clearly recite that each of the coatings possess such capability, the '205 patent can no longer be relied upon as an anticipatory reference. The more detailed recitation in the amended claims that the indicia of tampering be produced in the respective coating places additional limits on how broadly the Examiner can construe the claim language under MPEP 2111. Since all such interpretations must be "consistent with the specification", and the specification clearly teaches a top and bottom coating configured to respond to different modes of tampering attack in different ways, the Applicants submit that the Examiner may no longer take the position that the top layer (i.e., the toner-adhesion enhancing coating **16**) of the '205 patent is capable of satisfying the more detailed limitation of the amended claims.

By virtue of the '205 patent not having two tamper-evident coating layers that each can deliver a separate warning, its continued use as an obviousness rejection is also defective. One of the requirements of a *prima facie* case for obviousness is that all of the claim limitations must be taught or suggested (MPEP 2143.03), and on its face the '205 patent fails this requirement for the reasons discussed above. Since none of the secondary references (including Taylor et al (US 6,062,604), Berson (US 5,932,870), Halbrook, Jr. et al (US 5,883,043) or Lu (US 5,591,527)) correct this deficiency, the Applicants respectfully submit that the present claim amendments overcome the Examiner's obviousness rejection.

Dependent claim 2 has an additional distinguishing feature not found in the '205 patent. Specifically, there is no showing in the '205 patent that a first coating layer exhibits a color change as its notorious indicia of tampering and a second layer exhibits a patterned warning message as its notorious indicia of tampering, both as recited in claim 2. In fact, with only a single coating layer configured as a tamper-evident layer, the device of the '205 patent is

incapable of satisfying the claim. As such, the continued use of the '205 patent as an anticipatory reference for claim 2 is unavailing.

In conclusion, the Applicants respectfully submit that the amended independent claims are in condition for allowance. Furthermore, since all of the claims that depend from the independent claims place further limits thereon, the Applicants are of the belief that they too are in condition for allowance. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, notification of allowable subject matter is respectfully solicited.

Respectfully submitted,  
DINSMORE & SHOHL L.L.P.

By /John D. Reed/  
John D. Reed  
Registration No. 46,506

One Dayton Centre  
One South Main Street, Suite 1300  
Dayton, Ohio 45402-2023  
Telephone: (937) 449-6453  
Facsimile: (937) 449-6405  
e-mail: [john.reed@dinslaw.com](mailto:john.reed@dinslaw.com)